

## **STRAITS SETTLEMENTS REPORTS.**

### **IN THE MATTER OF AN APPLICATION BY MESSRS. WILLIAM JACKS & CO., LTD. AND IN THE MATTER OF AN OPPOSITION BY MESSRS. FUSSELL & CO., LTD.**

[Trade Marks Application (A. H. Harrison, Registrar of  
Trade Marks) March 20, 1941]

*Trade Marks Ordinance—Application to register  
a trade mark—Opposition on ground that use of  
mark by applicant would cause confusion—Discretion  
of the Registrar.*

The applicants applied to register a mark consisting of the representation of a Pyramid, formed by a succession of horizontal red lines, with the word Pyramid, also in red, underneath. The opposition was lodged by Messrs Fussell & Co. on the ground of resemblance to their trade mark, which consisted of a pictorial representation of the sphinx in the foreground and to the left of the sphinx and slightly in the background, a device of a Pyramid. At the top of this mark appeared the words "Sphinx Brand" whilst underneath these words were five Chinese characters, the transliteration and translation of which were "Kim Chee Ta Ghee Nee" meaning "Pyramid Cows Milk." The representations were in black upon a white ground. It was argued for the opponents that they had used for some time past a certain Trade Mark and that if the applicants use the mark for which the application was made upon the same or upon a similar kind of goods, confusion will be caused.

Held, that the opponents have not proved that they were entitled to the sole use of the words Kim Chee Tah or the Chinese characters representing them apart from and divorced from their mark as a whole; that the mark in respect of which the registration was applied for by the applicants was not by itself similar to that used by the opponents; and that it was not shown that the use of the mark would be likely to deceive or cause confusion.

On all these grounds the Registrar decided to exercise his discretion under the Trade Marks Ordinance to allow the mark to be entered in the Register.

*Cases referred to:—*

- (1) *Payton & Co. Ltd. v. Snelling, Lampard & Co., Ltd.* 17 R.P.C. 628.
- (2) *E. P. Mohamed Noordin v. S. E. S. Abdul Kareem & Co. and another* 48 R.P.C. 503.
- (3) *Re Chemische Fabrik Greshem Elektron* 27 R.P.C. 201.
- (4) *R. Johnston & Co. v. Archibald Orr Erving & Co.* (1882) L.R. 7 A.C. 219.
- (5) *Re Huxley's Application* 41 R.P.C. 423.

C. P. Burke for William Jacks & Co. (Malaya)  
Ltd., Applicants.

K. E. W. Hatchard for Fussell & Co. Ltd.,  
Opponents.

The facts and arguments sufficiently appear from the judgment.

**A. H. Harrison (Registrar):—**This is an Opposition to the Registration of a mark in Class 29 in respect of Sweetened Condensed Milk and Dairy Products, in the name of William Jacks & Co. (Malaya) Ltd.

The application is numbered 5449, and the mark concerned consists of the representation of a pyramid, formed by a succession of horizontal red lines, with the word Pyramid, also in red, underneath.

The Opposition is lodged by Messrs. Fussell & Co., Ltd. and the grounds of Opposition are as follows:—

Resemblance to Messrs. Fussell & Co., Ltd's Trade Mark Application No. 6903 in Class 29 in respect of "Milk, whether fresh, sterilised, evaporated, powdered, dried, sweetened, condensed, unsweetened condensed, skimmed, condensed skimmed, partially skimmed, malted, acidified, irradiated, vitaminised; all other kinds of milk; cream, butter, cheese and all other milk products included in Class 29."

The Opponents' mark as it appears upon the application form of No. 6903 consists of a pictorial representation of the sphinx in the foreground and to the left of the sphinx and slightly in the background, a device of a Pyramid. At the top of the mark appear the words "SPHINX BRAND" whilst underneath these words are five Chinese characters, the Transliteration and Translation of which are given as "Kim Chee Ta Ghee Nee", meaning "Pyramid Cows Milk." The representations are in black upon a white ground.

Evidence has been filed by both the Opponents and the Applicants and Mr. Hatchard for the Opponents and Mr. Burke for the Applicants appeared before the Registrar in the matter.

The evidence of the Opponents consists of three declarations. The first is by Kenneth Erskine Imrie, Joint Manager for Malaya, British North Borneo and Sarawak of Messrs. Nestle's & Anglo-Swiss Milk Products Ltd., who are stated to be the distributors in the Colony of the products of the Opponents. The second is made by Quek Seng Kee, who is described as the Acting Manager of Hock Seng & Co., dealers in cigarettes, flour, milk &c. and the third is by Wee Thiam Siew, the Managing Proprietor of Ban Leong & Co., who are dealers in cigarettes, tobaccos and Milk. I will deal firstly with the declarations of the two last mentioned persons, which are in substantially

the same form. Both Quek Seng Kee and Wee Thiam Siew state that they know the firm of Nestle's & Anglo-Swiss Milk Products Ltd., who have been the distributors of inter alia the goods of Messrs. Fussell & Co., Ltd. They then go on to make identically worded statements as follows:—

"To my personal knowledge, the said Fussell & Co. Limited have sold Sweetened Condensed Milk in the Straits Settlements bearing the trade mark now produced and shown to me marked "A" since June 1939 or earlier." "The said Trade Mark consists of a representation of a pyramid and a representation of sphinx together with the English words "Sphinx Brand" and Condensed Milk" and the Chinese characters the transliteration of which is 'Kim Chee Ta' meaning 'Gold Character Pagoda'". "Although the literal translation of the Chinese Characters 'Kim Chee Ta' is Gold Character Pagoda', the characters 'Kim Chee Ta' are used by the Chinese speaking public to express the conception of the English word "Pyramid" irrespective of the colour of the pyramid. To the best of my knowledge and belief, there is no single Chinese character which is the equivalent of 'Pyramid', the characters 'Kim Chee Ta' are the Chinese equivalent of 'Pyramid', and the said trade mark is universally known to the Chinese speaking public as 'Kim Chee Ta', the goods bearing the said trade mark are known to the said public as "Kim Chee Ta Brand" the said trade mark has become associated in the minds of the public with the goods sold by the said Fussell & Co. Limited and is distinctive of the said goods." "From my experience in the retail trade in the Straits Settlements, I am satisfied that any trade mark which consists of a pyramid would be known to the Chinese speaking public as 'Kim Chee Ta', and, if more than one pyramid trade mark were allowed to be used in connection with the sale of Sweetened Condensed Milk or other milk products confusion and deception would arise."

The declaration of Kenneth Erskine Imrie states that the mark has been bona fide used by Messrs. Fussell & Co., Ltd., in relation to Sweetened Condensed Milk imported and sold in the Colony since June 1939. Since the date of first user there has been a substantial amount of business conducted in the milk sold under this mark.

The statement continues:—

The said trade mark is known to the Chinese public throughout the Straits Settlements as 'Kim Chee Ta' and by virtue of user, the said goods bearing the said trade mark have come to be associated in the minds of the public with the goods of the said Fussell & Co., Ltd. and the said trade mark is therefore distinctive of these goods.

To each of the three declarations there is exhibited a copy of the mark, differing in colour to that shown upon the Application form of No. 6903 and having at the bottom the words Condensed Milk. The Representations shown are in the colours red, yellow and black and in an admixture of these colours.

The Applicants filed in evidence four Declarations. One of these, by Kwong Chai Juan, who is the

Managing Partner of Coffee Trading Company, carrying on business as provision dealers and merchants states:—

I agree that Sphinx Brand Milk sold by the firm of Nestle and Anglo-Swiss Milk Products Limited is more generally known as 'Kim Chee Tah' 金字塔 brand, but say that this Sphinx Brand Milk is also known among the actual consumers as Ho Nuey Tau 婦女頭 which means Woman's Head Brand.

Declarations are made by Tong Wai Kow, a Salesman of Wing Onn & Co., General Merchants and Tong Kee, a Salesman of Chop Kwong Onn, Sundry Goods Dealers. Both these declarations are to the effect that the persons concerned have had dealings in "Pyramid" handkerchiefs or handkerchiefs upon which the device of a pyramid has been used as a Trade Mark for many years. These handkerchiefs are made by Messrs. Tootal Ltd., and a representation of a pyramid which is almost identical with the mark of the Applicants—except that it is shown in black and white—is attached to each declaration. Tong Wai Kow then states:—"In the trade and among customers of my firm and throughout Malaya Pyramid Handkerchiefs are known as 'Sam Kok' 三角 Mark handkerchiefs. I have never heard any other Chinese name used for them", while Tong Kee also states:—

The handkerchiefs bearing the Pyramid Brand are universally known among the Chinese community throughout Malaya both among dealers and consumers as "Sam Kok 三角 Mark which means triangle or three cornered brand. These Chinese words are used by my firm in their bills, and invoices to describe Pyramid Handkerchiefs; and, to the best of my knowledge, information and belief in the Books, Invoices and Bills of many other dealers.

A further declaration by Tan Keng Siew is put forward, exhibiting the original sketch or drawing of the label incorporating the Applicants' Mark, which it is proposed to use.

In his address to the Registrar, Mr. Hatchard recapitulated the evidence contained in the declarations lodged by him and stated that so far as the declaration of Mr. Imrie is concerned, that person, by virtue of his extensive knowledge of the milk trade was in a position to make such statements as he did, although he had no knowledge of the Chinese language.

It was suggested that the evidence of the Applicants, concerned as it was with the trade in handkerchiefs, had no relation to the trade in milk, and that statements by persons engaged in the handkerchief trade were doubtful evidence in an enquiry relating to the trade concerned in milk. It was also asked, as it usually is in such cases, why, with

unnumbered designs open to the Applicants, should they choose the particular design which they have done.

Mr. Burke firstly queried the ability of Mr. Imrie to make his declaration, when there was no evidence of his ability to speak or understand Chinese. He pointed out that the Opponents had used the mark for a period of roughly one and a half years. He referred to the statements to the effect that the mark was "Universally known to the Chinese speaking public as 'Kim Chee Ta'", and that "Goods bearing the Trade Mark are known to the public as 'Kim Chee Ta Brand' and that "The Trade Mark has become associated with the goods sold by the said Fussell & Co., Ltd., and is distinctive of such goods", and suggested that, bearing in mind that the mark had been in use for such a short period, these statements were exaggerated.

I think that at this stage I should state briefly the matter upon which I am asked to give a decision.

The Opponents state that they have used for some time past a certain Trade Mark and that, if the Applicants use the mark which is the subject of these proceedings upon the same or upon a similar kind of goods, confusion will be caused. This is denied by the Applicants for registration.

To give a decision in such a case as this is always a difficult matter, as it must of necessity entail the consideration of what may happen in the future—a task which is more difficult than that of considering facts and actions which have actually taken place in the past, and the value of such Judgment can only be measured in the future. It is a further handicap that a decision can only be arrived at by a consideration of facts set forth in evidence. In the present case I have had so little evidence placed before me that the task becomes even more difficult. I receive no aid from the "Man in the Street"—who is the person most concerned because I have no evidence from him. I must therefore give my decision upon what evidence I have before me. There is little precedent to aid me but perhaps this does not matter, as the case is one that can only be judged upon its particular merits. I quote Lord Watson's words, when he said. "How can observations of Judges upon other and quite different facts bear upon the present case, in which the only question is what is the result of the evidence."

What law I have to guide me here seems clear. First, I refer to Section 23 (1) of the Trade Marks

Ordinance, 1938 which states "It shall not be lawful to register as a trade mark or part of a trade mark any matter, the use of which would by reason of its being calculated to deceive or cause confusion or otherwise be disentitled to protection in a Court of Justice, or would be contrary to law or morality, or any scandalous design". Secondly we have Section 31; "Except as provided by section 33 no trade mark shall be registered in respect of any goods or description of goods which is identical with one belonging to a different proprietor which is already on the Register with respect to such goods or description of goods or so nearly resembling such a trade mark as to be likely to deceive or cause confusion."

The Opponents' mark is not on the Register, but there is evidence that they have in fact used it in the Colony for some time, while it is stated that the mark of the applicants has not yet been used. It is clear therefore that, if the Applicants' mark is likely to cause confusion when used at the same time as the Opponents' mark, it should be refused.

I must now consider whether it would be likely to cause confusion. I have before me statements made on behalf of the Opponents to the effect that in the opinion of the deponents any Trade Mark which consists of a pyramid would be known to the Chinese speaking public as 'Kim Chee Ta', and, if more than one Pyramid trade mark were allowed to be used in connection with the sale of Sweetened Condensed Milk or other Milk Products confusion and deception would arise. The question whether confusion is likely to ensue is the question which I am called upon to decide. In *Payton & Co. Ltd. v. Snelling, Lampard & Co. Ltd.*<sup>(1)</sup> Lord Macnaghten commenting on the evidence and on questions having been put to witnesses whether a person going into a shop as a customer would be deceived said:—

"But that is not a matter for the witness; it is a matter for the Judge. The Judge looking at the exhibits before him and also paying attention to the evidence adduced, must not surrender his own independent judgment to any witness whatever."

I am told by the Manager of the Opponents that the trade mark is known to the Chinese throughout the Straits Settlements as Kim Chee Ta and the goods bearing the said trade mark are associated in the minds of the public with the goods of the Opponents. The wording of this statement, should be studied with care. I am not told that the milk sold by the Opponents is known by the term Kim Chee Ta, but that the mark is known by that name. Wee Thiam Siew and

Quek Seng Kee declare that "the goods bearing the said Trade Mark are known to the public as Kim Chee Ta Brand." I should like at this point to refer to a Judgment of Lord Russell of Killowen in the action of *E. P. Mohamed Noordin v. S. E. S. Abdul Kareem & Co. and another*<sup>(2)</sup>. This Judgment is perhaps of greater interest, in that it is one given in connection with an appeal from a Judgment of the Court of Appeal of this Colony. The matter concerned two marks each of which contained the device of a hat, and which were used in connection with Sarongs. In his judgment His Lordship states:—

"The point upon which, in their Lordships' view, the determination of this appeal depends can now be stated, namely, did the Plaintiffs by their evidence establish that their goods are known as 'Chop Topi goods' so that a person would be deceived by C. 3 into thinking that sarongs bearing that label were sarongs of the Plaintiffs? In other words, did the Plaintiffs prove that their sarongs are known as Chop Topi goods generally, apart from the representation of the particular form of Topi, namely a fez or tarboosh? The answer to this crucial question must necessarily depend upon the evidence available in the case."

It would appear then that, in order to prevent the present Applicants from using as a Trade Mark the device of any pyramid, the Opponents must first prove that they have an exclusive right to the use of a pyramid as a mark for milk. In this connection Lord Russell continuing his Judgment says:—

"Before the Plaintiffs can assert a right to prevent that user, they must establish as a condition precedent that they have an exclusive right to use a cap or hat as a mark, and this they have failed to do."

Further reference may be made to R.P.C. 27, page 201, where there is reported the application for Registration of a mark by *Chemische Fabrik Greshem Elektron*<sup>(3)</sup>. In this case it was found that the mark of the Opponents had in fact attained a secondary meaning, and that the mark of the Applicants would without doubt be referred to by the same words or name as the mark of the Opponents, and Registration was refused. Similarly, an injunction was granted in the case of *R. Johnston & Co. v. Archbald Orr Erving & Co.*<sup>(4)</sup>. In this case it was held that the second or new mark would undoubtedly be referred to by the name "Two Elephants", by which name the goods of the other party were known. In each of these cases, the devices shown upon the marks were similar to each other.

I am therefore shewn by previous records that I must decide this particular case upon the facts as they are presented to me. Having studied the evidence of

the Opponents I must consider that of the Applicants. There are two Declarations before me, in similar terms, which exhibit a Trade Mark almost identical to that proposed to be used by the Applicants. Both deponents who have had many years experience in the business of selling handkerchiefs—the goods in connection with which the exhibited mark is used—state that the handkerchiefs are known as "Sam Kok Mark" handkerchiefs. "Sam Kok" is the Chinese for "Three Cornered" or "Triangle." Another deponent, who is the Managing Partner in a business of provision dealers and merchants, states that while the Opponents' milk is more generally known as "Kim Chee Tah" brand, it is also known among the actual consumers as "Ho Nuey Tau" which means "Woman's Head Brand."

I cannot see why the average Chinese purchaser should make a difference when describing a mark when it is used on handkerchiefs and the same mark when it is used upon milk. If he describes the handkerchief mark as "Sam Kok", surely he would describe the same mark on a tin of milk in the same manner.

Regarding my duty in the matter I can do no better than to quote the words of Lord (then Mr. Justice) Tomlin in the case of *Huxley's Application*<sup>(5)</sup>:—

"I have not merely to look at the marks by reference to their physical appearance, and the comparison of them as physical objects affecting the eye, but I have to regard what is likely to be their effect in relation to any matter which may strike the ear, and, if I find that one mark may give rise to some description or name which will suggest the other mark, then that is a matter which I have to take into consideration."

With these words in my mind I cannot find that the Opponents' mark has acquired a secondary meaning apart from the mark itself. By this I mean that the public asking for Kim Chee Tah Brand Milk, would not, without also referring to the mark itself, expect to obtain the Opponents' milk. It is natural that the goods should be asked for by this name, because on the label there are the Chinese characters 金字塔 (Kim Chee Tah), and these are the only words which the Chinese speaking customer would understand. I cannot however find that the average Chinese person must use the same words to describe the mark of the Applicants. Indeed the evidence put forward by the Applicants leads me to believe that in all likelihood the goods will be referred to as "Sam Kok." There can I think be no two opinions upon the devices themselves.

The labels as such are not likely to be confused the one with the other.

I must therefore come to the following conclusions:—

- (a) That the Opponents have not proved that they are entitled to the sole use of the words Kim Chee Tah or the Chinese characters 金字塔 apart from and divorced from their mark as a whole,
- (b) That the mark in respect of which the Registration is applied for by the Applicants is not by itself similar to that used by the Opponents,

(c) That it is not proved that the mark of the Applicants will be generally referred to as "Kim Chee Tah Brand",

(d) That it is more likely to be referred to as "Sam Kok Brand."

It follows therefore that the use of the mark will not be likely to deceive or cause confusion.

By virtue therefore of the discretion given me by the Trade Marks Ordinance, I decide that the mark shall be entered upon the Register upon payment of the usual fees.

Costs will be awarded to the Applicants.

*Order accordingly.*

## F. M. S. REPORTS.

### LEE LAI FONG vs. PUBLIC PROSECUTOR.

[App. Crim. Juris. (Horne, J.) July 21, 1941]

*Road Traffic Enactment (17 of 1937), sections 12, 51, 80 and 113—"Using" a motor vehicle—Whether paid driver can be said to use the vehicle in contravention of the provisions of section 12, section 51 or section 80—Whether paid driver can in any circumstances abet the commission of offences against these sections—Effect of presumption established by section 113—Rebuttal of such presumption.*

The appellant was the driver, on three occasions, of a motor vehicle which was licensed and insured only as a private vehicle but which was carrying passengers who, the Magistrate found as a fact, had paid fares for their transport. The appellant was charged, in respect of each of these occasions, with having committed three separate offences of "using" the vehicle, contrary to the provisions of section 12, section 51 and section 80 of the Enactment respectively. The appellant was the son of the owner of the vehicle but was employed and paid by him to drive the car.

Held, (a) that the hired driver of a motor vehicle cannot be convicted of "causing the vehicle to be used" contrary to the provisions of section 80 (1).

(b) that a hired driver cannot be convicted of abetting the owner to "cause" the vehicle to be used contrary to the provisions of section 80; and

(c) that a hired driver cannot be convicted of abetting the owner to commit an offence against section 12 unless there is a finding that the owner himself caused or permitted the vehicle to be used contrary to the provisions of that section.

Appeal from the decision of the Magistrate, Seremban.

On a number of dates in November and December of 1940 the appellant was observed to be driving a

car containing a varying number of passengers. The car was the property of his father and was licensed and insured only as a private motor vehicle. In respect of each of three of such dates the appellant was charged with the following offences against the Road Traffic Enactment 1937:—

- (a) using the motor vehicle as a public service vehicle contrary to the provisions of section 12 (3);
- (b) using the motor vehicle without a policy of insurance which complied with the requirements of Part II, an offence under the provisions of section 51 (3); and
- (c) using the motor vehicle as a stage carriage, contrary to the provisions of section 80.

The appellant gave evidence and called witnesses with a view to establishing that the passengers were coolies and clerks employed by the owner of the car or other persons having business relations with the owner, and that none had paid any fare.

The Magistrate found that the presumption, established by the provisions of section 113 (2) of the Enactment, that the passengers had paid for their transport, was not rebutted by the evidence called for the defence, which he found to be untrue. The Magistrate further found that, since the insurance of the car did not cover its use for hire by passengers, there was a *prima facie* case, which had not been rebutted, that the car was not insured as required by the Enactment. He therefore convicted the appellant on all nine charges preferred against him and inflicted fines totalling ninety-six dollars. The appellant appealed.

*Cases referred to:—*

- (1) *Low Ah Seng v. P. P.* 1946 M.L.J. 48.